

1373.016

Group Art Unit
1623

Invention: **DETECTION OF EPITHELIAL DYSPLASIA**

703-872-9306

(Typed or Printed Name of Person Signing Certificate)

(Signature)

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In re application: Rutenberg, et al
Serial No.: 09/922,013
Filed: August 3, 2001
Art Unit: 1623
Examiner: W. H. Beisner
For: DETECTION OF EPITHELIAL DYSPLASIA
Docket No. 1373.016

November 10, 2003

VIA FAX (703) 308-4242

Hon. Commissioner of Patents & Trademarks
Washington, D. C. 20231

PETITION

Sir:

In response to the Notice of Abandonment dated October 30, 2003, transmitted herewith is a copy of the Amendment which was submitted in response to the Office Action of April 8, 2003, together with a copy of the fax confirmation report. Also transmitted are copies of the Amendment transmittal, Certificate of facsimile transmission and Petition for Extension of Time.

REMARKS

As can be seen from the documents transmitted herewith, an Amendment responsive to the Office Action of April 8, 2003 was timely faxed to the Patent Office on October 30, 2003 together with the appropriate Petition for Extension of Time.

In view of the above action and comments, the Notice of Abandonment should be withdrawn and the application be allowed.

Respectfully submitted,

LEVISOHN, BERGER & LANGSAM, LLP



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LEVISOHN LERNER

Fax:212-486-0323

Nov 10 '03

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LEVISOHN LERNER

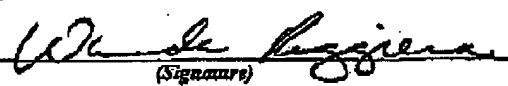
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**** Transmit Conf. Report ****

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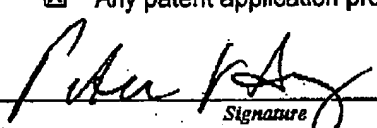
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|--|-------------------------------|---------------------------|------------------------|--|
| CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8) | | | Docket No. 1373.016 | |
| Applicant(s): Rutenberg, et al. | | | | |
| Serial No. 09/922,013 | Filing Date August 3, 2001 | Examiner W. H. Beisner | Group Art Unit 1623 | |
| Invention: DETECTION OF EPITHELIAL DYSPLASIA | | | | |
| <p>I hereby certify that this <u>Amend, transmittal, Amendment, Petition for Extension w/auth to chg dep acct</u> ★ (Identify type of correspondence) is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703-308-4242</u>) on <u>October 8, 2003</u> (Date)</p> <p style="text-align: right;">Wanda Ruggiera (Typed or Printed Name of Person Signing Certificate)  (Signature)</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p> | | | | |

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| Invention: DETECTION OF EPITHELIAL DYSPLASIA | | | |
| <p>I hereby certify that this <u>Amend. transmittal, Amendment, Petition for Extension w/auth to chg dep acct</u> [*] (Identify type of correspondence) is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703-308-4242</u>) on <u>October 8, 2003</u> (Date)</p> <p style="text-align: right;">Wanda Ruggiera (Typed or Printed Name of Person Signing Certificate) <u>Wanda Ruggiera</u> (Signature)</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p> <p>[*] and Change of address</p> | | | |

P18/REV01

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|--|-------------------------------------|-----------------------------|--------------------------------|-------------------------------|-------------------|
| AMENDMENT TRANSMITTAL LETTER (Small Entity) | | | | Docket No. 1373.016 | |
| Applicant(s): Rutenberg, et al. | | | | | |
| Serial No. 09/922,013 | Filing Date August 3, 2001 | Examiner W. H. Beisner | Group Art Unit 1623 | | |
| Invention: DETECTION OF EPITHELIAL DYSPLASIA | | | | | |
| <u>TO THE COMMISSIONER FOR PATENTS:</u> | | | | | |
| Transmitted herewith is an amendment in the above-identified application. | | | | | |
| <input checked="" type="checkbox"/> Small Entity status of this application has been established under 37 CFR 1.27 by a verified statement previously submitted. | | | | | |
| <input type="checkbox"/> A verified statement to establish Small Entity status under 37 FR 1.27 is enclosed. | | | | | |
| The fee has been calculated and is transmitted as shown below. | | | | | |
| CLAIMS AS AMENDED | | | | | |
| | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST # PREV. PAID FOR | NUMBER EXTRA CLAIMS PRESENT | RATE | ADDITIONAL FEE |
| TOTAL CLAIMS | 23 - | 26 = | 0 x | \$9.00 | \$0.00 |
| INDEP. CLAIMS | 5 - | 5 = | 0 x | \$42.00 | \$0.00 |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> | | | | | \$0.00 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | \$0.00 |
| <input checked="" type="checkbox"/> No additional fee is required for amendment. | | | | | |
| <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ | | | | | |
| <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. | | | | | |
| <input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 02-2105 | | | | | |
| <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. | | | | | |
| <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17. | | | | | |
|  Signature | | | Dated: October 8, 2003 | | |
| Peter L. Berger, Esq. Reg. No. 24,570 Levisohn, Lerner, Berger & Langsam, LLP 805 Third Avenue, 19th Floor New York, New York 10022 Phone (212) 486-7272 Fax (212) 486-0323 Customer Number 04617 | | | | | |
| CC: | | | | | |
| <div>I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</div> <div style="border-top: 1px solid black; height: 20px; margin-top: 5px;"></div> <div style="border-top: 1px solid black; height: 20px; margin-top: 5px;"></div> | | | | | |

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|---|------------------------------|----------------------------|--------------------------------------|
| Change Of Attorney Or Agent's Address In Application (37 CFR 1.8(a)) | | | Docket No. 1373.016 |
| In Re Application Of: Rutenberg, et al. | | | |
| Serial No. 09/922,013 | Filing Date 8/3/01 | Examiner Beisner | Group Art Unit 1623 |
| Invention: DETECTION OF EPITHELIAL DYSPLASIA | | | |
| TO THE COMMISSIONER FOR PATENTS | | | |
| <p>Please send all correspondence for this application to:</p> <p>Levisohn, Berger & Langsam, LLP 805 Third Avenue, 19th Floor New York, New York 10022</p> <p>Phone (212) 486-7272 Fax (212) 486-0323</p> <p>Please direct all telephone calls to:</p> <p>Peter L. Berger, Esq. Phone (212) 486-7272 ext. 302 Email pberger@LLBL.com</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"><div style="width: 45%;"> _____ <i>Signature of Attorney or Agent of Record</i></div><div style="width: 45%; text-align: right;">Dated: October 8, 2003</div></div> <div style="display: flex; justify-content: space-between; margin-top: 20px;"><div style="width: 45%; border: 1px solid black; padding: 5px;"><p>Peter L. Berger, Esq. Reg. No. 24,570 Levisohn, Berger & Langsam, LLP 805 Third Avenue, 19th Floor New York, NY 10022</p><p>Customer No. 04617</p><p style="font-size: small; text-align: center;"><i>Registration Number & Address of Attorney or Agent of Record</i></p></div><div style="width: 45%; border: 1px solid black; padding: 5px;"><p>I certify that this document is being deposited on with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p><p style="text-align: center; font-size: small;"><i>Signature of Person Mailing Correspondence</i></p><p style="text-align: center; font-size: small;"><i>Typed or Printed Name of Person Mailing Correspondence</i></p></div></div> | | | |

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Hon. Commissioner of Patents & Trademarks
Washington, D. C. 20231

AMENDMENT

Sir:

In response to the Official Action of April 8, 2003, please amend this application as follows:

IN THE CLAIMS:

Please cancel claim 23.

Please amend claims 26, 28 and 29 as follows:

26. (Thrice Amended) The system of claim 24, wherein ~~the location of said selected atypical cells are retrieved by said analytical apparatus for DNA ploidy analysis~~ comprise means to analyze such cells on a cell by cell basis and identifying the locations of said selected atypical cells.

28. (Thrice Amended) A system to detect precancerous and cancerous cells in a cell population, said cell population existing in epithelial tissue having an uppermost surface and tissue containing areas below said uppermost surface. said system comprising:

(a) brush means having sufficient stiffness to collect said cell population from said uppermost and said tissue containing areas below said uppermost surface.

(b) analytical apparatus comprising imaging apparatus for imaging said cell population,

(c) said imaging apparatus morphologically first selecting individual atypical cells from said cell population, and

(d) means to conduct DNA ploidy quantization of said selected individual atypical cells after said atypical cells are selected.

29. (Twice Amended) The system of claim 28, wherein said imaging apparatus comprises means to determine which of said ~~limit the~~ individual selected atypical cells ~~to be those which~~ are the most suspect atypical cells from said cell population.

REMARKS

Claims 23, 27 and 29 were rejected under 35 USC 112. Claim 23 has been cancelled while claims 27 and 29 have been amended to respond to the rejection.

All claims in this application have been rejected, primarily over the patent to Lee, 6,137,899. Lee has been combined with a number of other secondary references.

As discussed in the Office Action, Lee is concerned with a PAP-smear type of analysis which is a collection of surface cells for analysis. Claim 28, the only independent claim, has been amended to specifically recite that the cells being analyzed exist in epithelial tissue having an uppermost and tissue containing area below the uppermost surface with the brush means having sufficient stiffness to reach both the uppermost and area below said uppermost surface to collect cells. In this regard, the structure of the brush sampling means is materially different from the PAP-type brush or collection device of the prior art.

The combination of selecting cells from below the upper surface area enables improved determination of potential cancerous cells because of the early detection of subsurface cells which, if atypical, may lead to precancerous or cancerous conditions.

Clearly, the Lee reference does not show, suggest nor disclose such a combination including such a brush apparatus, nor does any of the other prior art, taken alone or in combination.

This application is a CIP of prior applications which relate to the significant improvement achieved by such reaching of such underlying surface areas.

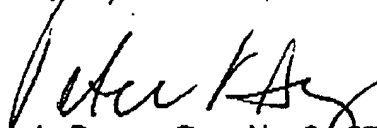
In view of the above action and comments, this application is believed in condition for allowance.

It is noted that none of the other references were discussed in detail in this response since most of those references were discussed with reference with the underlying applications relating to such brushing stiffness. Since Lee is primarily the newly cited art, that reference has now been distinguished.

A three month extension of time is concurrently sought herewith.

Respectfully submitted,

LEVISOHN, BERGER & LANGSAM, LLP



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